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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/334,978
Filing Date: June 17, 1999
Appellant(s): WEBBER ET AL.

Carol G. Stovsky
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 5, 2005 appealing from the Office action

mailed September 8, 2005.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

The Board's attention is drawn to the cancellation of claims 1-9 in this section of the

Appeal Brief. Examiner is in favor of this cancellation, as it reduces or simplifies the issues for

appeal.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

The amendment after final rejection filed on August 16, 2005 has not been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1.	5,715,448 A	Suzuki et al.	2-1998
2.	4,799,156	Shavit et al.	1-1989
3.	5,319,542 A	King, Jr. et al.	6-1994
4.	5,528,490 A	Hill	6-1996
5.	5,583,763 A	Atcheson	12-1996
6.	5,347,632 A	Filepp	9-1994

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 11, 13-26 are rejected under 35 U.S.C. 103(a).

These rejections are set forth in prior Office Action, Paper No 05032005 and reproduced

hereinbelow. The rejections which appear below substantially repeat the rejections made in the

previous Office Action (Paper Number 05032005). The text of those sections of Title 35 U.S.

Code relied upon in the Examiner's Answer is set forth in the previous Office action, Paper

Number 05032005.

1.   Claims 11, 13, 18-19, 21, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Suzuki et al., U.S. Patent Number 5, 715, 448, Shavit et al., U.S. Patent Number 4, 799,

156, King, Jr. et al, U.S. Patent Number 5, 319, 542 and Hill, U.S. Patent Number 5, 528, 490.

(A)   As per claims 11, 18, and 21, Suzuki teaches an electronic shopping method and

system, comprising

transmitting product information (Suzuki; Figure 2, column 3, lines 10-11) and updates to

product information (Suzuki; Figure 9, Item S12, column 5, lines 31-32, 47-48, column 8, lines 59-

64, column 9, lines 1-6) from a first merchant computer (Suzuki; Figure 1, Item 10 – Apparel

Manufacturer A) to a network host computer (Suzuki; Figure 1, Item 52, column 4, lines 22-23);

transmitting product information (Suzuki; Figure 2, column 3, lines 10-11) and updates to

product information (Suzuki; Figure 9, Item S12, column 5, lines 31-32, 47-48, column 8, lines 59-

64, column 9, lines 1-6) from a second merchant computer (Suzuki; Figure 1, Item 10 – Apparel

Manufacturer B, Figure 2, column 3, lines 10-11, column 4, lines 22-23) to said network host

computer (Suzuki; Figure 1, Item 52, column 4, lines 22-23);

storing said product information from said first merchant computer and said second merchant

computer in a database (Suzuki; see at least Figure 1, Item 53, column 4, lines 12-16, Figure 4);

establishing a network connection between a customer computer and said host computer in

communication with said database, said customer computer adapted to display information received

from said host computer (Suzuki; column 4, lines 22-29, Figure 2);

receiving at said host computer a search request from said customer computer for product

information from said database (Suzuki; column 8, lines 59-64, Figure 9, Item S12) said search

request comprising at least one search parameter for searching said database and selecting

product information from said database (Suzuki; column 8, lines 59-64, Figure 9, Item S12);

assimilating or processing said product information and said updated product information

from said database using said search parameter in accordance with said search request from said

customer computer (Suzuki; Figure 3, Figure 9, Item S12, column 5, lines 6-9, 31-32, 47-48, column

8, line 59 to column 9, line 6); and

displaying said assimilated or processed product information and said updated assimilated

product information at said customer computer (Suzuki; column 9, lines 1-6).

Although Suzuki discloses a system and method comprising product information not only

from a first and second merchant computer but also from a plurality of merchant computers, a

plurality of connections between said plurality of merchant computers and a host computer (Suzuki;

Figure 1, Items 10, 30, 40), Suzuki fails to explicitly disclose these limitations in accordance with

different types of network connectivity; and

transmitting from said network host computer to said customer computer said assimilated

product information and said updated assimilated product information;

wherein said continuous updates to said assimilated product information are assimilated

and transmitted by said network host computer if 1) said customer computer has requested

continuous updates to assimilated product information related to said search parameter in said

search request for product information; 2) said network host computer determines said first

merchant computer or said second merchant computer has transmitted updates to said product

information in said database related to said search parameter in said search request for product

information; and

searching said database using said search parameter to select product information

relevant to said search request; and

searching said database using said search parameter to select updated product information

relevant to said search request.

Shavit teaches an electronic shopping system and method which supports connections in

accordance with different types of network connectivity (Shavit; see at least Figure 1, Items 74a-

i, Item 79, column 5, lines 39-65); and

transmitting from said network host computer to said customer computer said assimilated

product information and said updated assimilated product information (Shavit; see at least Figure

18, Items 440, 446, column 6, line 51 to column 8, line 14, column 12, line 41 to column 13, line

26, column 40, lines 17-21);

wherein said continuous updates to said assimilated product information are assimilated

and transmitted by said network host computer if 1) said customer computer has requested

continuous updates to assimilated product information related to said search parameter in said

search request for product information; 2) said network host computer determines said first

merchant computer or said second merchant computer has transmitted updates to said product

information in said database related to said search parameter in said search request for product

information (Shavit; see at least Figure 18, Items 440, 446, column 6, line 51 to column 8, line

14, column 12, line 41 to column 13, line 26, column 40, lines 17-21); and

searching said database using said search parameter to select product information

relevant to said search request (Shavit; column 10, line 35, column 14, lines 56-61, column 15, lines

50-59, column 17, lines 11-14); and

searching said database using said search parameter to select updated product information

relevant to said search request (Shavit; column 6, line 51 to column 8, line 14, column 12, line 41

to column 13, line 26, column 40, lines 17-21).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the electronic shopping system and method of Suzuki, to include these

limitations, as taught by Shavit, with the motivations of providing an interactive business

transaction processing system permitting controlled on-line interactive concurrent electronic

access to various members of an industry, to freight, financial, and related services, and to

operational and commercial information data bases and computing services and to provide a

system for interactive on-line electronic communications and processing of business transactions

between a plurality of sellers and a plurality of buyers (Shavit; column 2, lines 5-19).

Although Suzuki teaches assimilating product information from said database in

accordance with said request from said customer computer for display at said customer

computer, Suzuki fails to explicitly disclose a system and method comprising assimilating

product information from said database in accordance with said request from said customer

computer for display in one presentation at said customer computer distinguishing said product

information from said first merchant computer from said product information from said second

merchant computer.

King teaches a system and method comprising assimilating product information from said database in accordance with said request from said customer computer for display in one presentation at said customer computer distinguishing said product information from said first merchant computer from said product information from said second merchant computer (King; column 1, lines 35-41, column 2, lines 1-11, column 7, lines 35-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the collective teachings of Suzuki and Shavit, to include a system and method comprising assimilating product information from said database in accordance with said request from said customer computer for display in one presentation at said customer computer distinguishing said product information from said first merchant computer from said product information from said second merchant computer, as taught by King, with the motivation of providing the purchaser a competitive shopping tool by offering comparative information on products offered by various suppliers simultaneously displayed, which would facilitate item selection (King; column 1, lines 35-41, column 2, lines 1-11).

Suzuki, Shavit and King fail to explicitly disclose determining whether updates to product information from said first merchant computer or said second merchant computer have been received at said network host computer and stored in said database.

However, the above features are well-known in the art, as evidenced by Hill.

In particular, Hill teaches determining whether updates to product information from said first merchant computer or said second merchant computer have been received at said network

host computer and stored in said database (Hill; column 3, lines 23-34, column 3, line 63 to

column 4, line 5).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to modify the combined teachings of Suzuki, Shavit and King to include determining

whether updates to product information from said first merchant computer or said second

merchant computer have been received at said network host computer and stored in said

database, as taught by Hill, with the motivation of providing the customer with an instantaneous

distribution of the latest catalog data available (Hill, column 2, lines 3-5).

(B)   As per claims 13, 19 and 26, Suzuki, Shavit, King and Hill teach the electronic

shopping system and method as analyzed and disclosed above in claims 11, 18 and 21 above

wherein said first type of network connectivity and said second type of network

connectivity are selected from the group of TCP/IP or SNA or X.25 connectivity (Shavit; column

5, lines 39-65).

The motivations for combining the respective teachings of Suzuki, Shavit, King, and Hill

are as given in the rejection of claim 11 above, and incorporated herein.

2.   Claims 14-15, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Suzuki, U.S. Patent Number 5, 715, 448, Shavit et al, U.S. Patent Number 4, 799, 156, King, Jr.

et al, U.S. Patent Number 5, 319, 542 and Hill, U.S. Patent Number 5, 528, 490, as applied to

claims 11, and 21 above, and further in view of Atcheson, U.S. Patent Number 5, 583, 763.

(A)   As per claims 14-15, 22-23, Suzuki, Shavit, King and Hill disclose an electronic

shopping system and method as discussed in the analysis of claims 11, and 21 above.

Suzuki, Shavit, King and Hill fail to expressly disclose an electronic shopping system

wherein said first network connection and said second network connection further comprise a

network connection between said first merchant computer and a regional host computer; a

network connection between said second merchant computer and said regional host computer;

and a network connection between said regional host computer and said network host computer,

wherein said regional host computer receives said product information from said first merchant

computer and said second merchant computer and transmits said product information to said

network host computer.

Atcheson teaches a network connection between said first merchant user computer and a

regional host computer (Atcheson; Figure 1, Item 110, column 3, lines 15-24) and also a network

connection between said second merchant user computer and said regional host computer (Atcheson;

Figure 1, Items 108, 110, 104, column 3, lines 15-24). Atcheson also discloses a regional host

computer adapted to facilitate said plurality of network connections between said plurality of

merchant computers and said host computer (Atcheson; Figure 1) and wherein said product

information is assimilated or processed at said regional host computer (Atcheson; column 3, lines

43-49, column 4, lines 37-42).

Atcheson also teaches a network connection between said regional host computer and said

network host computer, (Atcheson; Figure 1, Item 106) wherein said regional host computer

receives said product information from said first computer and said second merchant computer and

transmits said product information to said network host computer (Atcheson; Figure 1, Item 110, column 3, lines 15-38, Figure 2, column 4, lines 32-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method of Suzuki, Shavit, King and Hill to utilize connections to regional host computers in storing and transferring product information, as taught by Atcheson, with the motivation of adding functionality and efficiency purposes. For example, a regional host is able to act as a "front end" to host processing stations, to perform input and output (I/O) functions for each of the multiple terminals connected to it, to operate as a communications control station between user terminals and the host processing station, to possibly provide local storage for users, and to provide services to smaller groups of users on local networks, allowing more efficient and effective processing of information (Atcheson; column 3, lines 6-50).

The motivations for combining the respective teachings of Suzuki, Shavit, King, and Hill are as given in the rejection of claim 11 above, and incorporated herein.

3.   Claims 16-17, 20, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki, U.S. Patent Number 5, 715, 448, Shavit et al, U.S. Patent Number 4, 799, 156, King, Jr. et al, U.S. Patent Number 5, 319, 542 and Hill, U.S. Patent Number 5, 528, 490, as applied to claims 11, 18 and 21 above, and further in view of Filepp, U.S. Patent Number 5, 347, 632.

(A)   As per claims 16-17, 24-25, Suzuki, Shavit, King and Hill disclose an electronic shopping system and method as discussed in the analysis of claims 11 and 21 above.

Suzuki, Shavit, King and Hill fail to explicitly disclose a system and method wherein said first network connection comprises a switch in communication with said first merchant computer and said network host computer, said switch adapted to assimilate said product information from said first merchant computer and to transfer said product information to said network host computer and wherein said second network connection comprises a switch in communication with said second merchant computer and said network host computer, said switch adapted to assimilate said product information from said second merchant computer and to transfer said product information to said network host computer.

Filepp teaches wherein said first network connection comprises a switch in communication with said first merchant computer and said network host computer, said switch adapted to assimilate said product information from said first merchant computer and to transfer said product information to said network host computer and wherein said second network connection comprises a switch in communication with said second merchant computer and said network host computer, said switch adapted to assimilate said product information from said second merchant computer and to transfer said product information to said network host computer (Filepp; see at least Figure 1, Figure 2, column 1, lines 25-35, column 4, lines 19-42, column 5, lines 3-6, column , lines 28-61, column 7, lines 13-23, column 23, lines 31-36, column 24, lines 22-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method of Suzuki, Shavit, King and Hill to include wherein said first network connection comprises a switch in communication with said first merchant computer and said network host computer, said switch adapted to assimilate said product

information from said first merchant computer and to transfer said product information to said

network host computer and wherein said second network connection comprises a switch in

communication with said second merchant computer and said network host computer, said

switch adapted to assimilate said product information from said second merchant computer and

to transfer said product information to said network host computer, as taught by Filepp, with the

motivation of permitting a very large number of users to obtain access to a large number of

applications that have been created to enable the users to obtain information and transactional

services, and permitting the data and programs necessary to support applications including

interactive text/graphic sessions to be distributed over a computer network to enable the user to

obtain information and conduct shopping events (Filepp; column 2, lines 22-50).

The motivations for combining the respective teachings of Suzuki, Shavit, King, and Hill

are as given in the rejection of claim 11 above, and incorporated herein.

(B)   As per claim 20, Suzuki, Shavit, King, Hill and Filepp disclose an electronic

shopping system and method as discussed in the analysis of claim 18 above wherein said first

and second network connections are packet switch network, Ethernet, or modem or dial-up

connections (Shavit; column 1, lines 44-60), (Filepp; column 7, line 64 to column 8, line 2,

column 94, lines 29-41).

The motivations for combining the respective teachings of Suzuki, Shavit, King, Hill and

Filepp are as given in the rejection of claims 11 and 16 above, and incorporated herein.

(10)   Response to Argument

In the Appeal Brief filed December 5, 2005, Appellant makes the following argument:

VII.   Argument – 37 C.F.R 41.37 (c)(1)(vii)

Suzuki Fails To Teach Or Suggest "Transmitting Updates To Product Information"

Shavit Fails To Teach "Searching a Database to Select Updated Product Information
Relevant to a Search Request" or "Continuous Updates to Product Information Relevant
to a Search Request"

Hill Fails to Teach "Determining Whether Updates to Product Information from a First or
Second Merchant Computer Have Been Received at a Network Host Computer"

Examiner will address Appellant's arguments in sequence as they appear in the brief.

VII.   Argument – 37 C.F.R 41.37 (c)(1)(vii)

(A)   At the paragraph bridging pages 9-10 of the Appeal Brief filed December 5, 2005
Appellant argues that not all the claim limitations are taught by the applied art, and that the
application was not examined as a whole, and that there was no motivation to combine the
references other than improper hindsight. Examiner respectfully disagrees. In response, all of the
limitations which Applicant disputes as missing in the applied references have been fully
addressed by the Examiner as obvious in view of the collective teachings of Suzuki, Shavit,
King, Hill, Atcheson, and Filepp, based on the logic and sound scientific reasoning of one

ordinarily skilled in the art at the time of the invention, as detailed in the remarks and

explanations given in the preceding sections of the present Office Action and in the prior Office

Action (paper number 05032005), and incorporated herein. In particular, Examiner notes that the

recited features of transmitting updates to product information, searching a database to select

updated product information relevant to a search request, continuous updates to product

information relevant to a search request, and determining whether updates to product information

from a first or second merchant computer have been received at a network host computer are

taught by the combination of applied references.

Furthermore, the Examiner respectfully submits that obviousness is determined on the

basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re*

Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges,* 783 F.2d

1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki,* 745 F.2d 1468, 1472, 223

USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart,* 531 F.2d 1048, 1052, 189 USPQ 143,147

(CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of

presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of

corresponding claim elements in the prior art has been presented and since Examiner has

expressly articulated the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention. Note, for example, the motivations explicitly stated at lines 5-6,

page 8 of the previous Office Action (paper number 05032005), (i.e., " ... with the motivation of

providing the customer with an instantaneous distribution of the latest catalog data available ...

(Hill, column 2, lines 3-5).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or

modified and that there must be some reason why one skilled in the art would be motivated to

make the proposed modifications. However, although the Examiner agrees that the motivation or

suggestion to make modifications must be articulated, it is respectfully contended that there is no

requirement that the motivation to make modifications must be expressly articulated within the

references themselves. References are evaluated by what they suggest to one versed in the art,

rather than by their specific disclosures, *in re Bozek*, 163 USPQ 545 (CCPA 1969). Moreover, it

is noted that in the previous Office Action, each and every claimed limitation was carefully

analyzed and addressed in a detailed manner encompassing six different sections over fourteen

pages of text (see paper number 05032005, sections 3-8, pages 2-15).

In response to Applicant's argument that the Examiner's conclusion of obviousness is

based upon improper hindsight reasoning, it must be recognized that any judgment on

obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so

long as it takes into account only knowledge which was within the level of ordinary skill at the

time the claimed invention was made, and does not include knowledge gleaned only from the

Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392,

170 USPQ 209 (CCPA 1971).

In response to Appellant's arguments in which Appellant appears to apply *Interconnect

Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cri. 1985), Examiner respectfully notes that

since evidence of corresponding claim elements in the prior art has been presented and since

Examiner has expressly articulated the combinations and the motivations for combinations that

fairly suggest Applicant's claimed invention and since all of the applied references are in the same field as Appellant's claimed invention, the combination of references is proper.

At pages 10-20 of the Appeal Brief filed December 5, 2005, Appellant argues the applied references separately and argues each of the references individually. In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In particular, as demonstrated in the rejections of Claims 11, 18 and 21 above, the combined cited references of Suzuki, Shavit, King, Hill, Atcheson, and Filepp, teach wherein said updates to said assimilated product information are transmitted to said customer computer from said network host computer by said first computer program if 1) said customer computer has submitted a request to receive said updates to said assimilated product information at said customer computer and 2) said first merchant computer or said second merchant computer transmitted updates to said product information in said database at said network host computer. Specifically, Examiner notes, for example, that Suzuki teaches

> "[i]f the operation is a retrieval mode (step S11), the host computer 52 retrieves the integrated database DB 53 in accordance with the retrieval condition in response to the

request from the apparel manufacturer 10 or the textile company 20 (step S12), and the result is transmitted," (Suzuki; column 8, lines 59-64), (reads on "receiving at said host computer a search request from said customer computer for product information from said database" and "transmitting product information"); and

Shavit teaches an interactive online system where

"the system 50 can confirm available orders immediately" (reads on "receive said updates to said assimilated product information at said customer computer") (Shavit; see entire reference, and especially column 13, lines 64 to column 14, line 9); and

King teaches

"updating of the public cross-industry sector catalogs is accomplished by Suppliers whose catalog data is loaded using one of the following methods: ...[...]... B) real-time, on-line access for low volume or emergency updating" (reads on said first merchant computer or said second merchant computer transmitted updates to said product information in said database at said network host computer) and "The Private Catalog 110 can be updated by the Suppliers ...[...]...sending the modifications ...[...]...update directly to the Customer computer system" (reads on wherein said updates to said assimilated product information are transmitted to said customer computer from said network host computer by said first computer program) (King; see entire reference, and especially column 4, lines 2-15 and column 5, lines 21-23); and

Hill teaches

"The constant data updating step illustratively includes the steps of determining updated portions of the constant data stored in the main computer that are different than the constant data stored in the remote computer, transmitting the updated portions of the constant data stored in the main computer from the main computer to the remote computer, and replacing portions of the constant data stored on the remote computer with the updated portions of constant data received from the main computer" (reads on "determining whether updates to product information from a first or second merchant

computer have been received at a network host computer") (Hill; column 3, line 64 to column 4, line 5).

Suzuki Fails To Teach Or Suggest "Transmitting Updates To Product Information"

(A)   At pages10-12 of the Appeal Brief filed December 5, 2005 Appellant argues that the cited passages of the Suzuki reference fail to teach "transmitting updates to product information." Examiner respectfully disagrees. Firstly, Examiner notes that it is the entire combined applied reference(s), and not only the cited passages, that must be considered when evaluating whether or not the applied references teach the recited limitations.

In addition, Examiner interprets Suzuki's teachings of :

"If the operation is a retrieval mode (step S11), the host computer 52 retrieves the integrated database DB 53 in accordance with the retrieval condition in response to the request from the apparel manufacturer 10 or the textile company 20 (step S12), and the result is transmitted to each company. The details of the retrieval processing will be explained later. If all registration processings are finished (step S13), the operation returns to step S2, and a next command analysis is carried out.

At the time of retrieval, goods data of the textile, which satisfies the retrieval condition, business transaction data (by which the state of sales can be confirmed), and the image of the textile as required can be seen through the terminal 12 of the apparel manufacturer 10 and the terminal 22 of the textile company 20" (Suzuki, column 8, line 59 to column 9, line 6),"

and Suzuki's teachings of

"the content of the textile receiving and issuing order DB 535C is renewed [reads on
"updated"] based on the issuing data (quantity of issued orders)," (Suzuki, column 9,
lines 25-27)

as teaching this limitation. Further, Examiner notes that although the word "update" is not recited

in this passage, Examiner interprets the information observed to be information that is present "at

the time of retrieval" or new or updated information. As such, it is unclear as to how or why

Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps

Appellant is relying on features not expressly recited in the claims, but disclosed in the

specification. With regard to Appellant's argument in the paragraph bridging pages 10-11 that

Suzuki does not teach "transmitting new information about the same product or products that the

user searched previously," as apparently disclosed in the Appellant's specification, Examiner

respectfully notes that this is not a claimed limitation. Moreover, it has been held that although

the claims are interpreted in light of the specification, limitations from the specification are not

read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Shavit Fails To Teach "Searching a Database to Select Updated Product Information Relevant to
a Search Request" or "Continuous Updates to Product Information Relevant to a Search
Request"

(A)   At pages 12-16 of the Appeal Brief filed December 5, 2005 Appellant argues that

the cited passages of the Shavit reference fail to teach "searching a database to select updated

product information relevant to a search request" or "continuous updates to product information

relevant to a search request." Examiner respectfully disagrees. Firstly, Examiner notes that it is

the entire combined applied reference(s), and not only the cited passages, that must be

considered when evaluating whether or not the applied references teach the recited limitations.

In addition, Examiner interprets Shavit's teachings of :

"the user selects ...search the catalogue, etc." (Shavit; column 10, lines 34-35); and

"Each distributor may present its customers with different choices in its menu since the
distributor may choose the services it prefers to offer and the different types of data bases
and service levels it desires to make available. A typical distributor's menu may present
catalogue/price list inquiry [reads on "search"], enter/modify request for quotation
(RFQ), review proposals, enter an umbrella agreement, enter/amend/confirm an order,
inquiry and report, enter/review payments, and mortgage of orders/invoices. To identify
an item to be referred to after a choice is made, the system supports multiple alternative
keys for accessing the same item. For example, if a part number is not known, the user
may enter a "?" with parts of the description [reads on "search"], and the system will
display all the items that need such description segments and allow the user to request the
desired one. Additionally, the system allows multiple types of reference among different
items. Such references may be substitution, complementary, one-way replacement,
documentation for an item, a component relationship, etc. At any point the user may
review information about related items such as possible substitutes. The system also uses
the complementary relationships to recommend additional or substitute items at ordering
sessions." (Shavit; column 12, line 45 to column 13, line 9); and

Shavit's teachings of:

"Additionally, the system can produce either reports or answers to inquiries at the buyer's
request, subject to approval of the information provider, on a wide selection of
information about its orders, shipments, invoices, outstanding loads, usage of various
items, etc. (Shavit; column 14, lines 56-61)

as teaching "searching said database using said search parameter to select product

information relevant to said search request".

Furthermore, Examiner notes that throughout the Shavit reference, continuous updating

of databases takes place. For example, see Shavit's teachings of

"The user may select a general INFORMATION SERVICES FUNCTION 120 which

permits the user to access a wide variety of information services such as data base

services or computing services ... [...] ... The PROCUREMENT PROCESS 124 may be

selected, which allows the buyer to place orders and perform other related operations ...

[...] ... The FINANCIAL SERVICES function 128 provides for financial institutions to

extend financing to buyers ... [...] ... If the buyer at functional block 114 desires to end

the transaction, the system 50 branches to functional block 134 to end the session as

indicated by functional block 136, thereby updating control information" (Shavit; column

9, lines 14-34); and

"processing flow continues to block 440, where all relevant data bases are updated"

(Shavit; column 27, lines 49-51)."

Moreover, Examiner interprets Shavit's teachings of

"The system 50 also allows the supplier to provide its customers with an on-line

interactive sales service providing immediate quotations, confirmations, and status

information [reads on "continuous updates"]" (Shavit; column 15, lines 45-48);

"Various transactions may involve an interactive mode in which complete interactive

service is provided with immediate confirmation based on a local system data base.

Interactive service may also be based upon a data base residing in another subscriber's

remote computing center such that the interactive process requires retrieving and

modifying information on the remote data base. In addition, an interactive mode is provided in which the system computer translates and transmits transactions to and from a user subscriber's computer system" (Shavit; column 8, lines 5-14)

to teach "continuous updates to said assimilated product information are assimilated and transmitted by said network host computer" (as recited), and "continuous updates to product information relevant to a search request" (as argued).

Hill Fails to Teach "Determining Whether Updates to Product Information from a First or Second Merchant Computer Have Been Received at a Network Host Computer"

(A)   At pages 16-19 of the Appeal Brief filed December 5, 2005 Appellant argues that the cited passages of the Hill reference fail to teach "determining whether updates to product information from a first or second merchant computer have been received at a network host computer." Examiner respectfully disagrees. Firstly, Examiner notes that it is the entire combined applied reference(s), and not only the cited passages, that must be considered when evaluating whether or not the applied references teach the recited limitations.

In addition, Examiner interprets Hill's teachings of:

"The constant data updating step illustratively includes the steps of determining updated portions of the constant data stored in the main computer that are different than the constant data stored in the remote computer, transmitting the updated portions of the constant data stored in the main computer from the main computer to the remote computer, and replacing portions of the constant data stored on the remote computer with

the updated portions of constant data received from the main computer" (Hill; column 3, line 63 to column 4, line 5)

to teach "determining whether updates to product information from said first merchant computer or said second merchant computer have been received at said network host computer."

As per Appellant's arguments in paragraph 2 on page 17 of the Appeal Brief that "determining updated portions of data at a main computer that are different than data stored at a remote computer is not the same as determining whether new or updated data has been received at a computer," Examiner fails to understand the difference between "a computer" and "a remote computer."

With regard to Appellant's argument on pages 18-19 of the Appeal Brief that the Hill reference "teaches away" from Appellant's invention, Examiner respectfully disagrees. Hill teaches "to provide the customer with an instantaneous distribution of the latest catalog data available" (Hill, column 2, lines 3-5) and "[i]f a constant data update is required, this update is completed" (Hill, column 2, lines 13-14). Furthermore, in one element of Hills invention "[t]he catalog system of the present invention automatically determines when it is necessary to log on to vendor's computer to retrieve additional data." Examiner interprets these teachings as having the same objectives voiced in Appellant's specification and as such, as not teaching away from Appellant's invention.

With regard to Appellant's arguments that there is no motivation to combine the Hill

reference, Examiner respectfully disagrees, and notes that the Hill reference is in the same field

as the other references and attempts to solve the same problems. Furthermore, the Examiner

respectfully submits that obviousness is determined on the basis of the evidence as a whole and

the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24

USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686

(Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984);

and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this

standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case

of obviousness has at least been satisfied, since evidence of corresponding claim elements in

the prior art has been presented and since Examiner has expressly articulated the combinations

and the motivations for combinations that fairly suggest Applicant's claimed invention. Note,

for example, the motivations explicitly stated at lines 5-6, page 8 of the previous Office Action

(paper number 05032005), (i.e., " ... with the motivation of providing the customer with an

instantaneous distribution of the latest catalog data available ... (Hill, column 2, lines 3-5).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or

modified and that there must be some reason why one skilled in the art would be motivated to

make the proposed modifications. However, although the Examiner agrees that the motivation

or suggestion to make modifications must be articulated, it is respectfully contended that there

is no requirement that the motivation to make modifications must be expressly articulated

within the references themselves. References are evaluated by what they suggest to one versed

in the art, rather than by their specific disclosures, *in re Bozek*, 163 USPQ 545 (CCPA 1969).

Conclusion

Appellant's arguments at pages 9-20 of the Appeal brief submitted December 5, 2005 do not appear to persuasively require a withdrawal of the Examiner's grounds of rejection. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art. As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner both in the present Examiner's Answer as well as the previous Office Action (Paper Number 05032005), *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Natalie Pass
Examiner
Art Unit 3626

NP

February 3, 2006

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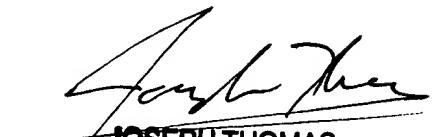
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